

II. Applicant's Remarks

By this amendment, claims 21 and 22 have been amended to improve grammar, form and/or punctuation, and not for a reason relating to patentability. The present amendment has no further limiting effect on the scope of claim 21. Claim 22 has been further amended to recite a “tapered knife” as supported on page 5, lines 32-33, of Applicant’s specification as originally filed.

New claims 41 through 48 have been added to claim an embodiment of the present invention described at page 5, line 30, through page 6, line 33, further comprising a “knife attached to a lower interior of the feed tube.” A variant of this embodiment is already claimed in previously presented claim 22. No claim has been narrowed for any reason related to patentability.

New claim 49 depends upon claim 41 and additionally recites that “the metal knife is attached to the interior of the feed tube and offset from a center axis of the feed tube so that the center axis of the feed tube does not pass through the metal knife” as shown in original Figure 8 of Applicant’s disclosure. New independent claims 50 and 51 incorporate subject matter of claims 21 and 41, respectively, and pertain to electric juicing device embodiments of the present invention as shown in original Figures 1 and 2.

The present amendment adds no new matter to the above-captioned application.

The present response addresses all of the issues raised by the Examiner in his Final Action, including those in response to applicant’s arguments, and confirms that the secondary indicia of non-obviousness of record is sufficient to rebut any alleged *prima facie* showing of obviousness made by the Examiner.

A. Interview with Applicant's Counsel of July 7, 2011

Applicant's counsel would like to thank Examiner Sang Paik for the courtesy of an interview on July 19, 2011, at which the outstanding rejections were discussed (See Examiner's Interview Summary, mailed July 22, 2011). Although Examiner Paik was kind enough to agree to consider the additional evidence without the filing of an RCE (Examiner's Interview Summary, mailed July 22, 2011), an RCE is filed herewith in view of the fact that new claims are presented.

The previously filed objective evidence of non-obviousness is not only commensurate in scope with the claimed invention, it is phenomenal. The overwhelming, phenomenal evidence is sufficient to overcome any alleged *prima facie* showing of obviousness, even if one were made in view of the cited references (which Applicant disputes).

B. The Invention

The present invention pertains broadly to a lid for an electric juicing device, and to an electric juicing device incorporating the lid. In accordance with an embodiment of the present invention, a lid for an electric juicing device is provided that includes features according to independent claim 21. In accordance with another embodiment of the present invention, a lid for an electric juicing device is provided that includes features according to independent claim 37. In accordance with another embodiment of the present invention, an electric juicing device is provided that includes features according to claim 50. In accordance with still another embodiment of the present invention, an electric juicing device is provided that includes features according to claim 51. Various other embodiments, in accordance with the present invention, are recited by the dependent claims.

An advantage provided by the lid according to the various embodiments of the present invention is that a lid for an electric juicing device, and the like, is provided that is commercially more acceptable than previously known alternative products.

C. The Rejections

Claims 21 and 26-29 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Harrison et al (US 5,495,795, hereinafter the “Harrison Patent”) in view of Knapp (US 2,289,656, hereinafter the “Knapp Patent”) or Doering (US 2,590,237, hereinafter the “Doering Patent”), and Prudomme (US 5,317,964, hereinafter the “Prudomme Patent”) or Nejat-Bina (US 5,636,923, hereinafter the “Nejat-Bina Patent”), and Rackov et al. (US 5,524,906, hereinafter the “Rackov Patent”). Claim 22 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over the Harrison Patent in view of the Knapp Patent or the Doering Patent, and the Prudomme Patent or Nejat-Bina Patent, and the Rackov Patent, and further in view of McClean et al. (US 5,479,851, hereinafter the “McClean Patent”). Claim 37 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over the Harrison Patent in view of the Knapp Patent or the Doering Patent, and the Prudomme Patent or Nejat-Bina Patent, and the Rackov Patent, and further in view of Tseng et al. (US 6,397,736, hereinafter the “Tseng Patent”).

Applicant respectfully traverses the Examiner’s rejections and requests reconsideration of the above-captioned application for the following reasons.

D. Applicant's Arguments

i. The Deficiencies of the Teachings of the Prior Art

a. Harrison

The Harrison reference discloses a unitary juice bowl cover of clear plastic of the type that the present invention is intended to improve upon. Harrison, column 8, lines 2-11.

There is, of course, no teaching of fabricating the cap of polymeric material and the feed tube of metal as claimed, because this would increase the cost and complexity of the device.

Making such a modification is clearly against the teachings of Harrison, whose objective is “to keep manufacturing costs to a minimum.” Harrison, column 1, line 44. Thus, Harrison, the main reference clearly teaches against the modifications required to arrive at the presently claimed invention.

b. Knapp

Knapp is typical of devices made in the 1940's made entirely of metal because proper polymeric materials where either not available or of insufficient quality to be used in a heavy duty device such as a juicer.

c. Doering

Doering is another example of a typical device made of metal, because suitable polymeric materials where not available. There is of course no teaching or suggestion of making a cap of polymeric material and a feed tube of metal and the engineering difficulties that would be encountered in such a combination—problems that needed to be solved to arrive at the present invention.

d. Prudomme

Prudomme is cited only for the proposition that devices can be made of plastic or stainless steel. Indeed, Prudomme contains no teachings relevant to the art of juicers. While Prudomme discloses a sieve for removing fat from fried foods, it does not disclose a feed tube as would be required for a juicer and contains no teaching relevant to why one of ordinary skill in the art would select a feed tube of metal or polymeric material. The sieve of Prudomme serves to allow material to pass through its walls and, therefore, serves the opposite purpose of the feed tube of the present invention. Combining the sieve of Prudomme with Harrison would produce a non-functional device.

e. Nejat-Bina

Nejat-Bina is no more relevant to the invention than Prudomme. The reference discloses a perforated cylinder of stainless steel in a recycle food mixer. Combining the perforated cylinder of Nejat-Bina with Harrison would also result in a non-functional device.

f. Rokov

Rokov discloses a gasket and to seal a joint connecting two sections of an exhaust system for a vehicle. Rokov is non-analogous art.

Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.”

In re Klein, --- F.3d ---, 2011 WL 2178134 (C.A.Fed.) (Fed. Cir. 2011), citing, In re Bigio, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

First of all, the Rokov relates “the disadvantages of the prior known exhaust system gaskets.” Rokov, column 1, lines 48-52. Thus, Rokov is not in the same field of endeavor as

the present invention. Second, there is no indication that Rokov has any relevance to the particular problem that the present invention seeks to solve, that is, the connection of a polymeric cap and a metal feed tube in a juicer.

g. **McClean**

McClean, like Harrison, discloses a unitary cover 15 and feed tube 16. Like Harrison, there is no teaching of making the feed tube of metal and a cap of polymeric material, because such a construction would increase the complexity and cost of the device.

As discussed below, the only teachings of record for making the claimed combination is in the present specification. The problem discovered, i.e., the lack of success of the unitary device due to breakage, and the difficulties encountered in solving this problem are discussed in detail below in conjunction with the Affidavit of Richard Hoare (of record).

ii. **Claim rejections under 35 U.S.C. §103**

A prima facie case of obviousness requires a showing that the scope and content of the prior art teaches each and every element of the claimed invention, and that the prior art provides some teaching, suggestion or motivation, or other legitimate reason, for combining the references in the manner claimed. KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 1739-41 (2007); In re Oetiker, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). Furthermore, a proper rejection under Section 103 requires showing (1) that a person of ordinary skill in the art would have had a legitimate reason to attempt to make the composition or device, or to carry out the claimed process, and (2) that the person of ordinary skill in the art would have had a reasonable expectation of success in doing so. PharmaStem Therapeutics, Inc. v. ViaCell, Inc., 491 F.3d 1342, 1360 (Fed. Cir. 2007). In this case, the Examiner has not established a *prima facie* case of obviousness against claims 21, 22, 26-29 and 41-51 because the combined disclosures of the Harrison Patent, the Knapp Patent, the Doering Patent, the Prudomme Patent, the Nejat-Bina

Patent, the Rackov Patent, the McClean Patent, and the Tseng Patent does not teach, or suggest, each and every claimed element arranged as in the claims, as arranged in the claims. The Examiner has adduced no legitimate reason to justify the combination of so many substantially different disclosures. Specifically, the Examiner has not done so in light of the clear teaching the art of Harrison and McClean against a separate metal feed tube and polymeric cap. The Examiner has also failed to establish that a person of ordinary skill in the art would have had a reasonable expectation of success of obtaining Applicant's claimed invention even if the combinations of art asserted by the Examiner were made.

a. There is no *prima facie* showing of obviousness under 35 U.S.C. 103(a)

The Examiner cites no less than six references in an ultimately unsuccessful attempt to establish a *prima facie* showing of obviousness. Specifically, claims 21, and 26-29 stand rejected under 35 U.S.C. §103(a) over Harrison et al (US 5,495,795) in view of Knapp (US 2,289,656) or Doering (US 2,590,237), and Prudomme (US 5,317,964) or Nejat-Bina (US 5,636,923), and Rackov et al. (US 5,524,906).

Applicant disagrees for the following reasons.

The fact that the Examiner requires no less than six substantially different references to postulate a *prima facie* showing of obviousness against the present claims is itself evidence that no *prima facie* obviousness exists. Instead, the Examiner employs the six disclosures as a mosaic to create an incomplete facsimile of the claimed invention, which is impermissible. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934-35 (Fed. Cir. 1990).

As shown by the testimony of Richard Hoare, during the development of the present invention, it was attempted to manufacture a commercial juicer with plastic lid, plastic feed tube and plastic knife. Affidavit of Richard Hoare, dated January 27, 2011, of record,

(hereinafter “Hoare Aff.”), ¶¶ 27-29. This product was unsuccessful because the knife inside the plastic feed tube started to break off. Consideration was given to making a stainless steel feed tube in combination with a diecast aluminum or zinc lid were abandoned because costs were prohibitive. Hoare Aff. ¶ 30. For these reasons, known only to applicant, the unique combination of the present claims was arrived at with much effort and experimentation.

In short, the evidence shows that the combination of plastic knife and plastic lid was unsuccessful in a commercial unit. Once the problem of the originally proposed combination was found to be unsuccessful and the problem related to its failure identified (i.e., the plastic feed tube and knife), Applicant put in much effort and experimentation before landing upon the claimed combination of plastic lid, feed tube and unique connection between feed tube and polymeric cap. Based on this evidence, the prior art did not enable Applicant’s claimed invention.

It is a well-settled proposition that to render a later invention unpatentable for obviousness, the prior art must enable a person of ordinary skill in the art to make and use the later invention. In re Kumar, 418 F.3d 1361, 1369 (Fed. Cir. 2005). The evidence from the Hoare Aff. demonstrates that initial attempts to produce a commercial juicer lid, as claimed, were unsuccessful. The evidence supports the conclusion that the combined disclosures of the Harrison Patent, the Knapp Patent, the Doering Patent, the Prudomme Patent, the Nejat-Bina Patent, the Rackov Patent, the McClean Patent, and the Tseng Patent does not enable those of ordinary skill in the art to make and use a “lid for an electric juicing device” as recited by claims 21, 22, 26-29 and 41-48.

It is another well-settled proposition that the Examiner must demonstrate that a person of ordinary skill in the art would have had a reasonable expectation of success of obtaining the claimed invention if the combination of disclosures asserted by the Examiner was made.

PharmaStem Therapeutics, Inc. v. ViaCell, Inc., 491 F.3d 1342, 1360 (Fed. Cir. 2007). In this

case, the evidence provided by the Hoare Aff, ¶¶ 27-29, demonstrates that a person of ordinary skill in the art would not have had a reasonable expectation of success of obtaining Applicant's claimed invention even if the combination of the Harrison Patent, the Knapp Patent, the Doering Patent, the Prudomme Patent, the Nejat-Bina Patent, the Rackov Patent, the McClean Patent, and the Tseng Patent, was made because it required Applicant undue experimentation to arrive at a commercially acceptable lid.

For all of the above reasons, the Examiner has not established a *prima facie* case of obviousness against claims 21, 22, 26-29 and 41-51.

b. Claim 22 and claims 41-48

Claim 22 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Harrison in view of Knapp or Doering, Prodhommme or Nejat-Bina, and Rackov, further in view of McClean et al. (US 5,479,851). The Examiner admits that absent McClean there is no showing of a metal knife in a feed tube (Office Action, dated April 12, 2011, at 3, lines 18-19). The McClean Patent discloses a "fruit and vegetable juicer" that includes a knife (17) located at the center of the guide tube (16) as shown in Fig. 3 reproduced below (McClean Patent, col. 60-67). The knife (17) is disposed so that central space (20) in pusher (19) envelopes the knife (17) when the food pusher (19) is pushed all the way down (McClean Patent, col. 2, lines 60-67). McClean is the exact type of juicer with plastic feed tube that the present invention was intended to improve upon.

As shown below, McClean clearly shows a unitary cover (15) and feed tube (16), so that modifying McClean to increase cost and complexity would inherently deviate from the teachings of the reference. McClean clearly does not solve the deficiencies of Harrison in failing to teach or suggest the presently claimed combination.

For all of the above reasons, the Examiner has not established a *prima facie* case of obviousness against claims 22 and new claims 41-48 of the above-captioned application.

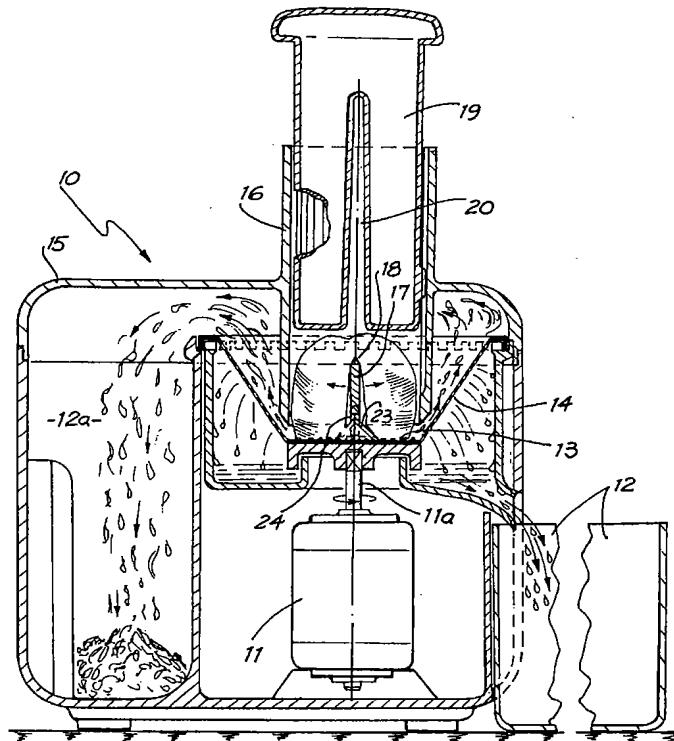


FIG. 3

The Examiner has also not established a *prima facie* showing of obviousness because the Examiner has failed to provide a valid reason, without reference to Applicant's disclosure, why the prior art would be combined to produce the claimed invention. Moreover, even assuming the Examiner had established a *prima facie* showing of non-obviousness (which is an invalid assumption), such a showing would be rebutted by the copious, phenomenal evidence of secondary indicia of non-obviousness of record in the present case.

c. The Examiner has shown no proper reason to combine the prior art outside of the applicant's own specification.

The only reason the Examiner gives for combining the prior art references is the teaching of the present application itself that the plastic feed tube and knife lead to failure in commercial devices. Uncovering the problem that the plastic knife broke off from the plastic feed tube, was the present inventor's discovery. This problem was discovered in the course of designing a commercial juicer. Hoare Aff. ¶ 19-26. The recognition of a problem not known in the prior art is at the heart of the present invention, and is itself a reason the present invention is patentable. See, e.g., Eibel Process v. Minnesota and Ontario Paper Co., 261 US 45 (1923) (holding that the discovery of the source of a problem may result in a patentable invention where the prior art does not teach the problem or its source). See also Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 935 (Fed. Cir. 1990).

It is improper in a rejection under 35 U.S.C. §103 to use hindsight and reference to the applicant's own specification to obtain a reason for making the asserted combination of references.

For all of the above reasons, the Examiner has failed to establish a *prima facie* showing of obviousness. Furthermore, for the reasons that follow, even if a *prima facie* showing of obviousness had been made, which applicant disputes, such a very weak showing would be rebutted by the phenomenal evidence of secondary indicia of non-obviousness contained in the Affidavit of Richard Hoare (filed previously) and of record.

ii. **Secondary Indicia of Non-Obviousness in the Affidavit are sufficient to rebut any *prima facie* showing of obviousness**

a. **Secondary Considerations for Non-obviousness, generally**

Title 35 U.S.C. § 103 requires that an invention be non-obvious to a person of ordinary skill in the relevant field in view of the “scope and content of the prior art.” Graham v. John Deere Co., 148 USPQ 459, 467 (U.S. 1966). Any differences between “the prior art and claims at issue” must also be considered. *Id.* at 467. Additionally, secondary considerations such as commercial success, industry recognition, such as licenses showing industry respect for the invention, and copying, are “essential components” in deciding questions of obviousness. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). Moreover, “all evidence of nonobviousness must be considered” when determining patentability. In re Soni, 54 F.3d 746, 750 (Fed. Cir. 1995); *see In re Sullivan*, 498 F.3d 1345, 1351 (Fed. Cir. 2007) (citing In re Sernaker, 702 F.2d 989, 996 (Fed. Cir. 1983)).

b. **Evidence of Extensive Research Preceding the Claimed Invention**

It is a well-settled proposition that evidence of extensive research preceding the claimed invention is evidence of its non-obviousness. In re Dow Chemical, 5 U.S.P.Q.2d 1529, 1532). In this case, the evidence according to the Hoare Aff., ¶¶ 27-32, establishes that it took about a year of design effort and testing to arrive at the claimed invention. Furthermore, the Hoare Aff., ¶¶ 15-18, establishes that there was a long felt and unresolved need for a juicer lid in accordance with the present invention. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 935 (Fed. Cir. 1990). Applicant contends that this evidence of extensive research preceding the claimed invention, and the evidence of long felt and

unresolved need, is evidence of the non-obviousness of the invention, sufficient to overcome the Examiner's alleged *prima facie* case of obviousness.

c. Commercial Success

Commercial success that "results from the claimed invention" is a relevant indication of non-obviousness. Ecolochem, Inc. v. Southern Cal. Edison Co., 227 F.3d 1361, 1377 (Fed. Cir. 2000) (quoting J.T. Eaton & Co. v. Atlantic Paste & Glue Co., 106 F.3d 1563, 1571 (Fed. Cir. 1997)); Specialty Composites v. Cabot Corp., 845 F.2d 981, 991 (Fed. Cir. 1988) (giving weight to the commercial success of earplugs as the success was found to be "due to the merits of the invention"). Moreover, commercial success is relevant to the issue of non-obviousness "wherever such success occurs." Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1461 (Fed. Circ. 1984) (citing Weather Engineering Corp. v. United States, 614 F.2d 281 (1980)) (holding that evidence of commercial success in a foreign country should be considered).

Since 2007, more than 600,000 units of the claimed juicer have been sold. This amounts to sales of \$Au229 million. Hoare Aff. ¶¶13,14. These sales are phenomenal and demonstrate unequivocally the enormous demand for the improvements of the claimed invention. These sales roughly equal the sales of the relatively cheaper models with plastic feed tubes.

There is a presumption that a product is commercially successful "[w]hen a patentee can demonstrate. . . significant sales in a relevant market" of the patented or claimed product, Ecolochem, 227 F.3d at 1377; WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1360 (Fed. Cir. 1999) (emphasis added) (holding that evidence indicating a significant majority of slot machines sold globally are the patented virtual reel slot machine was indicative of commercial success).

The sales of the presently claimed commercial juicer are more than significant, they are phenomenal. Thus commercial success sufficient to rebut any *prima facie* showing of obviousness must be presumed in the present case. *Id.*

The enormous commercial success of the commercial juicer due to the same key features in the present claims is strongly indicative that the claimed invention is not obvious.

d. Acquiescence by Others to the Validity of the Patent

Another objective indication of non-obviousness is acquiescence by others in the industry to the validity of the patent, such as by settlement of infringement suits, Bettcher Industries, Inc. v. Bunzl USA, Inc., 692 F.Supp.2d 805, 819 -820 (N.D. Ohio, 2010) (a successful settlement with another competitor that resulted in the competitor's product being withdrawn from the market is evidence of industry acquiescence of the validity of the patent), or licensing that shows "industry respect," WMS, 184 F.3d at 1359 (citing In re Rouffet, 149 F.3d at 1355) (stating that licensing by competitors is indicative of non-obviousness).

In the present case, the makers of the Sunbeam Café Series Juicers (JE 8600 and JE 8600R) acquiesced in the validity of Australian Patent AU 2004253180 (AU '180), filed concurrently herewith in an Information Disclosure Statement of the same date. Hoare Aff. ¶¶ 43-47. AU '180 claims priority of the same Australian application as the present invention (i.e., AU 2003903367). *Id.* The claims of the Australian patent correspond substantially to the present claims. *Id.* When confronted with accusations of infringement, makers of the Sunbeam Juicers made undertakings not to market or sell the Sunbeam Juicers in the future. *Id.* This is more evidence of the non-obviousness of Applicant's claimed invention.

e. Copying

Copying of a patented product by a competitor indicates the product is not obvious.

Specialty Composites, 845 F.2d at 991 (quoting Windsurfing Int'l Inc. v. AMF, Inc., 782 F.2d 995, 1000 (Fed. Cir. 1986), *cert. denied*, 477 U.S. 905 (1986)); *see also* Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc., 344 F.3d 1186, 1196 (Fed. Cir. 2003) (citing Vandenberg v. Dairy Equip. Co., 740 F.2d 1560, 1567 (Fed. Cir. 1984)).

The copying of the claimed juicers by the makers of the Sunbeam Juicers is further strong, direct and unequivocal evidence of the non-obviousness of the presently claimed invention. See Hoare Aff. ¶ 43-52.

In sum, when the Examiner properly considers the totality of Applicant's evidence of (i) long felt and unresolved need for the claimed invention, (ii) extensive research preceding the claimed invention, (iii) evidence of the commercial success of the claimed invention, (iv) evidence of copying of the claimed invention, and (v) evidence of acquiescence of others to the validity of substantially similar claims in a corresponding foreign patent, the Examiner should conclude that any alleged *prima facie* case of obvious based on the combined disclosures of eight patents, namely, the Harrison Patent, the Knapp Patent, the Doering Patent, the Prudomme Patent, the Nejat-Bina Patent, the Rackov Patent, the McClean Patent, and the Tseng Patent, has been overcome. This is particularly true since any *prima facie* case, if it were to exist, is particularly weak in view of the patchwork of six or more references required by the Examiner to reject the claims.

In other words, the totality of Applicant's rebuttal evidence shows that there was an established and long felt need for the invention and, through extensive research, Applicant identified and solved the technical problems that lead to the presently claimed invention. Then, once the presently claimed invention was produced commercially, it sold like hotcakes. Also, competitors copied the invention, and even acquiesced to the validity of a foreign

patent having substantially the same claimed invention as the present application. Taken as a whole, all of these facts demonstrate the non-obvious nature of the presently claimed invention in a manner sufficient to overcome any alleged *prima facie* case of obviousness.

For all of the above reasons, the Examiner should conclude that the invention according to claims 21, 22, 26-29 and 41-51 is patentable as non-obvious over the art of record.

III. Conclusion

Accordingly, for all of the above reasons, a *prima facie* showing of obviousness has not been made against the presently claimed invention in view of the cited art of record. However, even if there were a *prima facie* showing, which applicant disputes, the phenomenal evidence of (i) long felt and unresolved need for the claimed invention, (ii) extensive research preceding the claimed invention, (iii) evidence of the commercial success of the claimed invention, (iv) evidence of copying of the claimed invention, and (v) evidence of acquiescence of others to the validity of substantially similar claims in a corresponding foreign patent, is sufficient to rebut any *prima facie* showing.

Thus claims 21, 22, 26-29, and 41-51 are believed to be in condition for allowance, and prompt notice of allowance is earnestly solicited.

The below-signed attorney for Applicant welcomes any questions.

Respectfully submitted,

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